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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)

Denise E. SMITH et al.)

Group Art Unit: 2643

Application No.: 09/611,196)

Examiner: R. Barnie

Filed: July 6, 2000)

For: SYSTEMS AND METHODS)
RELATING TO MULTIPURPOSE)
CARDS)

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TRANSMITTAL FOR APPEAL BRIEF

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Sir:

Transmitted herewith in triplicate is an Appeal Brief in support of the Notice of Appeal
filed October 30, 2003.

The Commissioner is hereby authorized to charge \$ 330.00, and any other appropriate
fees that may be required by this paper that are not accounted for above, and to credit any
overpayment, to Deposit Account No. 13-2491. This paper is submitted in triplicate.

Respectfully submitted,

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Date: December 30, 2003



PATENT
Attorney Docket No. ATL-99-003

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of)
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APPEAL BRIEF

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Customer Window, **Mail Stop Appeal Brief - Patents**
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

This Appeal Brief is submitted in triplicate in response to the final Office Action, mailed July 1, 2003, and in support of the Notice of Appeal, filed October 30, 2003.

I. **REAL PARTY IN INTEREST**

The real party in interest in this appeal is MCI WorldCom, Inc.

II. RELATED APPEALS AND INTERFERENCES

Appellants are unaware of any related appeals and interferences.

III. STATUS OF CLAIMS

Claims 1-4 and 6-30 are pending in this application. All of the pending claims are the subject of the present appeal.

IV. STATUS OF AMENDMENTS

No Amendments were filed after the final Office Action of July 1, 2003. A Request for Reconsideration was filed on August 26, 2003. A subsequent Advisory Action, dated October 8, 2003, indicated that the Request for Reconsideration was considered, but did not place the application in condition for allowance.

V. SUMMARY OF THE INVENTION

Systems and methods consistent with the principles of the invention provide multipurpose cards that effectively serve as low cost promotional or marketing tools. Figs. 1A and 1B illustrate an exemplary configuration of a multipurpose card 100. As illustrated, multipurpose card 100 may include a main portion 110 and a keytag portion 120. Multipurpose card 100 may be a calling card, a prepaid phone card, a credit card, a gift card, or the like (pg. 5, lines 3-6).

In one implementation, multipurpose card 100 has a size approximately the same as a conventional prepaid telephone calling card and is perforated such that keytag portion 120 may

be separated from main portion 110 (pg. 5, lines 10-13). The number of perforations may be chosen to not only allow for easy separation of main portion 110 and keytag portion 120, but to also hold portions 110 and 120 together during shipping (pg. 5, lines 13-16). In one implementation, multipurpose card 100 includes 5 or 6 perforations (pg. 5, lines 16-17). An adhesive label 105 may be placed on the perforated section of multipurpose card 100 to prevent unintentional separation of main portion 110 and keytag portion 120 (Fig. 1B; pg. 6, lines 11-14). As illustrated in Fig. 1D, keytag portion 120 may be separated from main portion 110 and placed on a key ring 130 via a hole 125 formed in keytag portion 120.

As illustrated in Figs. 2A-2C, the front of main portion 110 and keytag portion 120 may be configured to display a company logo (pg. 7, line 20, to pg. 8, line 1), a personal expression (e.g., "Congratulations," "Thank You," or the like) (pg. 8, lines 1-5), and/or other information, such as photographs of family members (pg. 8, lines 5-8).

Fig. 7 illustrates an exemplary process for issuing a multipurpose card 100. The process is described for explanatory purposes in connection with a business ordering a group of multipurpose prepaid calling cards 100 to promote a new product. Processing may begin with the business requesting the purchase of the multipurpose cards 100 (act 710, Fig. 7; pg. 14, lines 7-10). The request may include information identifying the quantity to be purchased, the number of minutes to be allocated to each of the multipurpose cards 100, an expiration date (if any), and the type of information that should be displayed on cards 100, such as a business logo, information related to the new product being offered by the business, etc. (pg. 7, lines 11-15).

Upon receiving the request, an operator may interact with a card issuing device 410 (Fig.

4) to input the quantity and type of cards to be issued and the personal information to be displayed (act 720, Fig. 7; pg. 14, lines 16-19) to cause card issuing device 410 to retrieve the quantity and type of cards 100 and add the personal information (e.g., business logo, new product information, etc.) and possibly an identification number to main portion 110 and/or keytag portion 120 of the multipurpose cards 100 (act 730, Fig. 7; pg. 14, lines 19-20; pg. 15, lines 4-6). An exemplary configuration of card issuing device 410 is illustrated in Fig. 5. Card issuing device 410 may then output the multipurpose prepaid calling cards 100 (act 740, Fig. 7; pg. 15, lines 7-8).

VI. ISSUES

Whether claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28, and 29 are unpatentable under 35 U.S.C. § 103(a) over Holstrom (U.S. Patent No. 5,570,081) in view of Taskett (U.S. Patent No. 5,684,291);

Whether claim 2 is unpatentable under 35 U.S.C. § 103(a) over Holstrom (U.S. Patent No. 5,570,081) in view of Taskett (U.S. Patent No. 5,684,291), and further in view of Small (U.S. Patent No. 5,513,117);

Whether claims 7, 12, 15, 16, 20, 22, 23, and 25-27 are unpatentable under 35 U.S.C. § 103(a) over Holstrom (U.S. Patent No. 5,570,081) in view of Small (U.S. Patent No. 5,513,117); and

Whether claim 30 is unpatentable under 35 U.S.C. § 103(a) over Holstrom in view of Taskett, and further in view of MacWilliams et al. (U.S. Patent No. 6,385,860).

VII. GROUPING OF CLAIMS

Appellants are satisfied to let claims 1, 3, 4, 6, and 28 stand or fall together, claim 2 stand or fall alone, claims 7, 14-18, 21, 22, and 24-26 stand or fall together, each of claims 8-13, 19, 27, 29, and 30 stand or fall alone, and claims 20 and 23 stand or fall together. The patentability of each of these different groups of claims is argued separately in the Argument section below.

VIII. ARGUMENT

- A. **The rejection of claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28, and 29 under 35 U.S.C. § 103(a) as unpatentable over Holstrom (U.S. Patent No. 5,570,081) in view of Taskett (U.S. Patent No. 5,684,291) should be REVERSED.**

Claims 1, 3, 4, 6-11, 13, 14, 16-19, 21, 22, 24, 28, and 29 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Holstrom in view of Taskett. The arguments below use claim 1 as representative of the group of claims including claims 1, 3, 4, 6, and 28; and claim 7 as representative of the group of claims including claims 7, 14, 16-18, 22, and 24.

Holstrom is directed to a lost article tracking system (Abstract).

Taskett is directed to a refundable prepaid telephone card (Abstract).

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention always rests upon the Examiner. In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In rejecting a claim under 35 U.S.C. § 103, the Examiner must provide a factual basis to support the conclusion of obviousness. In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). Based upon the objective evidence of record, the Examiner is required to make

the factual inquiries mandated by Graham v. John Deere Co., 86 S.Ct. 684, 383 U.S. 1, 148 USPQ 459 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been realistically motivated to modify an applied reference and/or combine applied references to arrive at the claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

In establishing the requisite motivation, it has been consistently held that the requisite motivation to support the conclusion of obviousness is not an abstract concept, but must stem from the prior art as a whole to impel one having ordinary skill in the art to modify a reference or to combine references with a reasonable expectation of successfully achieving some particular realistic objective. See, for example, Interconnect Planning Corp. v. Feil, 227 USPQ 543 (Fed. Cir. 1985). Consistent legal precedent admonishes against the indiscriminate combination of prior art references. Carella v. Starlight Archery, 804 F.2d 135, 231 USPQ 644 (Fed. Cir. 1986); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

With these principles in mind, Appellants' claim 1 recites a multipurpose calling card that includes a calling card portion and a key ring portion that is separable from the calling card portion. The size of the multipurpose calling card is approximately the size of a conventional calling card. Holstrom and Taskett do not disclose or suggest this combination of features.

For example, Holstrom and Taskett do not disclose a multipurpose calling card that includes a calling card portion and a key ring portion. The Examiner relies on Figs. 1 and 2 of Holstrom for allegedly disclosing these features (final Office Action, pg. 2). Appellants submit

that these figures of Holstrom do not disclose or suggest a multipurpose calling card that includes a calling card portion and a key ring portion.

Figs. 1 and 2 of Holstrom depict front and back views of a two-piece detachable card, including a base 10 and a tag 12, that is used for tracking lost articles. As disclosed by Holstrom, a user may attach tag 12 to an article, such as a key ring, and place base 10 in a secure place, such as a wallet (col. 3, lines 3-8). If the key ring is subsequently lost, the person finding the key ring may call the number 22 listed on tag 12 and leave a voice message for the owner of the key ring (col. 3, lines 9-21). The owner may retrieve the voice message by dialing the number 24 on base 10 (col. 3, lines 22-29).

Contrary to the Examiner's allegation, Holstrom does not disclose or suggest that base 10 is a calling card portion, as required by Appellants' claim 1. By stark contrast, Holstrom's base 10 is merely a card that displays a telephone number that a user may call to retrieve a voice message left by someone finding tag 12.

Moreover, Appellants submit that it would not have been obvious to modify Holstrom's lost article tracking card to be a calling card because such modification would dramatically change the very operation of the Holstrom system.

Further with respect to this feature, the Examiner alleges that "the combination including Holstrom teaches a calling card or a card with which one can make a telephonic connection based on an identifier unique or associated with the card over a network comprising of two portions including a tag portion and a key ring portion (see abstract, figs. 1-3)" (Advisory Action, pp. 2-3).

Appellants strenuously disagree.

Holstrom is specifically directed to a lost article tracking card. Holstrom in no way discloses or suggests that the lost article tracking card is a calling card, as the term calling card is conventionally used in the art. Moreover, Holstrom discloses that base number 18 and tag number 20 are used to access a specific voice mailbox related to the owner of the lost article tracking card. Contrary to the Examiner's allegation, Holstrom does not disclose or suggest that these unique identifiers are used to make telephonic connections over a network.

Holstrom and Taskett do not further disclose that the size of the multipurpose card is approximately the size of a conventional calling card, as also recited in Appellants' claim 1. The Examiner relies on col. 2, lines 47-53, of Holstrom for allegedly disclosing this feature (final Office Action, pg. 2). This section of Holstrom does not disclose or suggest this feature of claim 1.

Col. 2, lines 47-53, of Holstrom discloses:

A typical embodiment of the two-piece detachable card of the present invention is illustrated in FIG. 1 (front view) and FIG. 2 (back view). In the preferred embodiment, the two-piece detachable card is flexible plastic similar in scope to a standard credit card. However the invention can consist of other material such as rubber, wood, metal, cardboard, paper, etc.

While this section of Holstrom discloses that the two-piece detachable card can be made from a material that is similar to that used in standard credit cards, this section of Holstrom does not disclose or suggest that the size of the two-piece detachable card is approximately the size of a

conventional calling card.

Further with respect to this feature, the Examiner alleges that "the combination as set forth in the rejection of the claimed subject matter does not put a restriction on the size of the calling card such as taught by Holstrom" (final Office Action, pg. 9; Advisory Action, pg. 2). Initially, Appellants note, as set forth above, that Holstrom does not, contrary to the Examiner's allegation, disclose or suggest a calling card. Moreover, the mere fact that the disclosure of Holstrom does not put a restriction on the size of the lost article tracking card is merely conclusory and insufficient for establishing a *prima facie* basis of obviousness with respect to a particularly claimed feature.

The Examiner further alleges with respect to this feature that "all calling cards do not have the same size" (final Office Action, pg. 9; Advisory Action, pg. 2). As described on page 5, lines 10-13, of Appellants' specification, conventional prepaid telephone calling cards are approximately 3.375 inches wide and 2.125 inches high. The combination of Holstrom and Taskett do not disclose or suggest a multipurpose card that is approximately the size of a conventional calling card.

The Examiner relies on Taskett for alleged teaching separating a card into two portions by means of perforations (final Office Action, pp. 2-3). Appellants note that Appellants' claim 1 does not require that the calling card portion and key ring portion be separable by "means of perforations," but merely recites that the key ring portion is separable from the calling card portion. Therefore, the Examiner relies on Taskett for teaching a feature that is not recited in

Appellants' claim 1. The disclosure of Taskett does not remedy the deficiencies in the disclosure of Holstrom set forth above.

For at least the foregoing reasons, Appellants submit that the rejection of claim 1 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Appellants' independent claim 7 recites receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. Holstrom and Taskett do not disclose this combination of features.

For example, Holstrom and Taskett do not disclose receiving personal information or customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. The Examiner relies on Fig. 1 of Holstrom for allegedly disclosing these features and alleged that "[t]he personal information would simply read on the card user identifier such as displayed by Holstrom" (final Office Action, pg. 3). Appellants disagree with the Examiner's interpretation of the Holstrom disclosure.

Fig. 1 of Holstrom discloses a front view of a two-piece detachable card that includes a base 10 and a tag 12. Base 10 includes a base number 18 and tag 12 includes a tag number 20 (see col. 2, lines 30-35). Holstrom discloses that a person finding tag 12 may call the number 22 listed on the back of tag 12 (col. 3, lines 9-14). Upon calling the number, the finder may be prompted to enter tag number 20 (col. 3, lines 14-16). By entering tag number 20, the finder may

leave a voice message for the owner (col. 3, lines 16-21). In a similar manner, the owner may use base number 18 to access the voice message (col. 3, lines 22-29).

Holstrom in no way discloses or suggests that base number 18 and tag number 20 are personal information. Put another way, Holstrom does not disclose or suggest that the owner of the two-piece detachable card may customize the two-piece detachable card with base number 18 and tag number 20. The Examiner fails to point to any section of Holstrom that discloses the reception of base number 18 and tag number 20 and customizing base 10 and tag 12, respectively, with these numbers.

Further with respect to this feature, the Examiner alleges that "personal information is broad and can be read on a unique identifier such as a PIN on an article" (final Office Action, pg. 10; Advisory Action, pg. 3). Irrespective of the veracity of this allegation, Holstrom does not disclose or suggest customizing base 10 or tag 12 of the lost article tracking card with a PIN. Therefore, the Examiner's allegation that personal information can be read on a PIN is immaterial since Holstrom does not disclose or suggest customizing the lost article tracking card with a PIN or any other personal information. The Examiner fails to point to any section of Holstrom that discloses customizing base 10 or tag 12 with a PIN.

The Examiner further alleges that "[t]he fact that the personal information can be a specific information or customized by a user/purchaser/manufacture to be a specific information is not directed to the claimed subject matter" (final Office Action, pg. 10). The Examiner's allegation fails to address the fact that Holstrom and Taskett, whether taken alone or in any reasonable combination, do not disclose or suggest receiving personal information, generating

one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information, as recited in Appellants' claim 7.

For at least the foregoing reasons, Appellants submit that the rejection of claim 7 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 8 recites that the generating includes generating one or more multipurpose calling cards. Claim 8 depends from claim 7 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 7. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 8, the Examiner alleges that "[t]he combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett" (final Office Action, pg. 4). The Examiner's allegation in no way addresses the feature of claim 8. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 8.

Further with respect to the feature in claim 8, the Examiner alleges that "the combination as set forth regarding Holstrom teaches a multi-purpose calling card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination could be applied to

any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" (final Office Action, pg. 10). Appellants disagree with the Examiner's allegation.

Initially, Appellants note that the Examiner alleges, without support, that Holstrom discloses a multipurpose calling card. As set forth above, Holstrom does not disclose or suggest a multipurpose calling card, but merely discloses a lost article tracking card. Moreover, the Examiner's conclusory statement that "the examiner ... believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" in no way addresses the specific feature recited in Appellants' claim 8 and is insufficient for establishing a *prima facie* basis for denying patentability.

For at least the foregoing reasons, Appellants submit that the rejection of claim 8 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 9 recites that the generating includes generating one or more multipurpose prepaid telephone cards. Claim 9 depends from claim 7 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 7. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 9, the Examiner alleges that "[t]he combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett" (final Office Action, pg. 4). The Examiner's allegation in no way addresses the feature of claim 9. Accordingly, a *prima facie* case of obviousness has not been

established with respect to claim 9.

Further with respect to the feature in claim 9, the Examiner alleges that "the combination as set forth regarding Holstrom teaches a multi-purpose calling card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" (final Office Action, pg. 10). Appellants disagree with the Examiner's allegation.

Initially, Appellants note that the Examiner alleges, without support, that Holstrom discloses a multipurpose calling card. As set forth above, Holstrom does not disclose or suggest a multipurpose calling card, but merely discloses a lost article tracking card. Moreover, the Examiner's conclusory statement that "the examiner ... believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" in no way addresses the specific feature recited in Appellants' claim 9 and is insufficient for establishing a *prima facie* basis for denying patentability.

For at least the foregoing reasons, Appellants submit that the rejection of claim 9 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 10 recites that the generating includes generating one or more multipurpose gift cards. Claim 10 depends from claim 7 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 7. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 10, the Examiner alleges that "[t]he combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett" (final Office Action, pg. 4). The Examiner's allegation in no way addresses the feature of claim 10. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 10.

Further with respect to the feature in claim 9, the Examiner alleges that "the combination as set forth regarding Holstrom teaches a multi-purpose calling card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" (final Office Action, pg. 10). Appellants disagree with the Examiner's allegation.

Initially, Appellants note that the Examiner's allegation does not address the specific feature recited in Appellants' claim 10. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 10. As set forth above, Holstrom discloses a lost article tracking card. Holstrom does not disclose or suggest a multipurpose gift card. Moreover, the Examiner's conclusory statement that "the examiner ... believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" in no way addresses the specific feature recited in Appellants' claim 10 and is insufficient for establishing a *prima facie* basis for denying patentability.

For at least the foregoing reasons, Appellants submit that the rejection of claim 10 under

35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 11 recites that the generating includes generating one or more multipurpose credit cards. Claim 11 depends from claim 7 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 7. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 11, the Examiner alleges that "[t]he combination including Taskett renders obvious the claimed subject matter because the ability to separate a card into two portions to include a key tag portion can be applied to any cards including a prepaid or calling cards as taught by Taskett" (final Office Action, pg. 4). The Examiner's allegation in no way addresses the feature of claim 11. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 11.

Further with respect to the feature in claim 11, the Examiner alleges that "the combination as set forth regarding Holstrom teaches a multi-purpose calling card including a key portion and a main portion and the secondary reference applied teaches a prepaid calling card thus the examiner in rejecting these claims believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" (final Office Action, pg. 10). Appellants disagree with the Examiner's allegation.

Initially, Appellants note that the Examiner's allegation does not address the specific feature recited in Appellants' claim 11. Accordingly, a *prima facie* case of obviousness has not

been established with respect to claim 11. As set forth above, Holstrom discloses a lost article tracking card. Holstrom does not disclose or suggest a multipurpose credit card. Moreover, the Examiner's conclusory statement that "the examiner ... believes the teaching of the combination could be applied to any card including pre-paid, calling cards and so forth thus rendering the claimed subject matter obvious" in no way addresses the specific feature recited in Appellants' claim 11 and is insufficient for establishing a *prima facie* basis of obviousness with respect to a particularly claimed feature.

For at least the foregoing reasons, Appellants submit that the rejection of claim 11 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 13 recites adding personalized information to both the main portion and the keytag portion of each multipurpose card. Claim 13 depends from claim 7 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 7. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

The Examiner relies on Figs. 1-4 of Holstrom for allegedly disclosing the feature of Appellants' claim 13 (final Office Action, pg. 4). Appellants disagree.

Fig. 1 of Holstrom discloses a front view of the two-piece detachable lost article tracking card. Fig. 2 of Holstrom discloses a back view of the two-piece detachable lost article tracking card. Fig. 3 of Holstrom discloses a tag piece attached to a set of keys. Fig. 4 of Holstrom discloses components of the computer-generated voice mail box system. Contrary to the Examiner's allegation, these figures in no way disclose or suggest adding personalized

information to both the main portion and keytag portion of each multipurpose card. As set forth above with respect to claim 7, Holstrom does not disclose or suggest the ability to add personalized information to a multipurpose card. Therefore, Holstrom cannot disclose adding personalized information to both the main portion and the keytag portion of each multipurpose card.

For at least the foregoing reasons, Appellants submit that the rejection of claim 13 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 19 recites that the multipurpose card is one of a calling card, a gift card, and a credit card. Claim 19 depends from claim 16 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 16. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 19, the Examiner alleges "[t]he combination teaches the claimed subject matter" (final Office Action, pg. 4). The Examiner fails to address the specific feature recited in Appellants' claim 19. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 19.

As set forth above, Holstrom discloses a lost article tracking card. Holstrom and Taskett, whether taken along or in any reasonable combination, do not disclose or suggest a multipurpose card that is one of a calling card, a gift card, and a credit card, as required by Appellants' claim 19.

For at least the foregoing reasons, Appellants submit that the rejection of claim 19 under

35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 29 recites creating 5 or 6 perforations between the first calling card portion and the second portion. Claim 29 depends from claim 28 and, therefore, is patentable over Holstrom and Taskett for at least the reasons given above with respect to claim 28. Moreover, this claim is patentable over Holstrom and Taskett for reasons of its own.

With respect to claim 29, the Examiner alleges that "the number of perforations would be a design choice" (final Office Action, pg. 5). The Examiner also alleges that "the combination including Taskett does not put a restriction on the number of perforation and therefore, would have been a matter of design choice" (final Office Action, pg. 11). These allegations were also reiterated on page 4 of the Advisory Action. The Examiner's allegations fail to provide the necessary showing to establish a *prima facie* case of obviousness.

It has been consistently held that the initial burden in establishing a *prima facie* case of obviousness is on the Examiner to show that the references expressly or impliedly suggest the claimed invention or, absent such an express or implied suggestion, provide a convincing line of reasoning as to why one skilled in the art would have found the claimed invention to have been obvious in light of the teachings of the references. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner has provided no evidence that Holstrom or Taskett suggest the feature of claim 29. Moreover, the Examiner's allegation that since Taskett does not put a limitation on the number of perforations, creating 5 or 6 perforations between the first calling card portion and the second portion, as recited in Appellants' claim 29, would have been a matter

of design choice, is merely conclusory and insufficient for establishing a *prima facie* case of obviousness.

For at least the foregoing reasons, Appellants submit that the rejection of claim 29 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett is improper. Accordingly, Appellants request that the rejection be reversed.

B. The rejection of claim 2 under 35 U.S.C. § 103(a) as unpatentable over Holstrom (U.S. Patent No. 5,570,081) in view of Taskett (U.S. Patent No. 5,684,291), and further in view of Small (U.S. Patent No. 5,513,117) should be REVERSED.

Claim 2 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Holstrom in view of Taskett, and further in view of Small.

Small is directed to a vending machine that allows a customer to design and personalize a greeting card and allows the customer to integrate an electronically vendable gift onto the card (Abstract).

Claim 2 recites that the key ring portion includes one or more of promotional information, personal expressions, and photographs. Claim 2 depends from claim 1. The disclosure of Small does not remedy the deficiencies in the disclosures of Holstrom and Taskett set forth above with respect to claim 1. Therefore, claim 2 is patentable over Holstrom, Taskett, and Small, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 1. Moreover, claim 2 recites additional features not disclosed or suggested by Holstrom, Taskett, or Small.

The Examiner admits that Holstrom and Taskett do not disclose the features of claim 2 and alleges that "[i]t's notoriously well known to have designs or advertisements by a card producer or telephone provider displayed on a calling card. Small teaches an apparatus for dispensing personalized gifts wherein a user can personalize information on a gift which according to Small could include prepaid telephone calling cards" (final Office Action, pg. 6).

The Examiner's allegations do not address the features recited in Appellants' claim 2. As set forth above, claim 2 recites that the key ring portion includes one or more of promotional information, personal expressions, and photographs. The Examiner's allegation that placing designs and advertisements on calling cards is notoriously well known, regardless of its veracity, does not address the placement of one or more of promotional information, personal expressions, and photographs on a key ring portion of a multipurpose calling card.

The Examiner relies on Small for allegedly supporting the allegation that placing designs and advertisements on calling cards is notoriously well known (final Office Action, pg. 6). Regardless of the veracity of this allegation, the Examiner does not allege nor does Small disclose the placement of one or more of promotional information, personal expressions, and photographs on a key ring portion of a multipurpose card, as required by Appellants' claim 2. The Examiner fails to point to any section of Holstrom, Taskett, or Small that discloses this feature.

The Examiner further alleges with respect to claim 2 that "[t]he combination fails to teach the possibility of being able to personalized the card to include personal information *as desired by the user of the card even though this limitation is not specifically directed to the claimed*

subject matter" (final Office Action, pg. 6, emphasis in original). Appellants note that claim 2 does not recite personalizing a card to include personal information, as alleged by the Examiner. Instead, claim 2 specifically recites that the key ring portion of a multipurpose calling card includes one or more of promotional information, personal expressions, and photographs. Therefore, Appellants assume that the Examiner is addressing, with respect to this allegation, a feature that is not recited in Appellants' claim 2.

The Examiner further alleges with respect to claim 2 that "being able to customize a card to include any desired information including personal expressions like greetings and so forth is well known such as taught by Small" (final Office Action, pg. 11). This allegation is reiterated on page 5 of the Advisory Action. Appellants submit that this allegation fails to address the specific feature recited in Appellants' claim 2. Claim 2 recites that the key ring portion includes one or more of promotional information, personal expressions, and photographs. The Examiner's allegation regarding placing information on a card does not address the specific feature recited in Appellants' claim 2. Moreover, the Small disclosure is directed to greeting cards and not, as recited in Appellants' claim 2, multipurpose calling cards.

Appellants further submit that even assuming, for the sake of argument, that Small discloses placing one or more of promotional information, personal expressions, and photographs onto a calling card, there is no motivation, absent Appellants' own disclosure, for combining this alleged teaching of Small with the disclosures of Holstrom and Taskett. With respect to motivation, the Examiner alleges "it would have been obvious ... to incorporate the teaching of Small into that of the combination thus making it possible to provide advertisement information

to card users and if the card is a gift, being able to personalize a card for the recipient" (final Office Action, pg. 6). The Examiner's motivation in no way addresses why one skilled in the art would seek to place one or more of promotional information, personal expressions, and photographs onto Holstrom's lost article tracking card.

Holstrom does not disclose or suggest a desire to include one or more of promotional information, personal expressions, and photographs onto its lost article tracking card. Moreover, Small does not disclose or suggest a desire to include one or more of promotional information, personal expressions, and photographs onto a lost article tracking card. In fact, the disclosure of Small is in no way related to lost article tracking cards. Appellants submit that the Examiner's motivation has been impermissibly gleaned from Appellants' own disclosure. As such, the combination of Holstrom, Taskett, and Small is improper.

For at least the foregoing reasons, Appellants submit that the rejection of claim 2 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett, and further in view of Small is improper. Accordingly, Appellants request that the rejection be reversed.

C. The rejection of claims 7, 12, 15, 16, 20, 22, 23, and 25-27 under 35 U.S.C. § 103(a) as unpatentable over Holstrom (U.S. Patent No. 5,570,081) in view of Small (U.S. Patent No. 5,513,117) should be REVERSED.

Claims 7, 12, 15, 16, 20, 22, 23, and 25-27 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Holstrom in view of Small. The arguments below use claim 7 as representative of the group of claims including claims 7, 15, 16, 22, 25, and 26; and claim 20 as representative of the group of claims including claims 20 and 23.

Claim 7 recites receiving personal information, generating one or more multipurpose cards, where each multipurpose card includes a main portion and a keytag portion and where the keytag portion is separable from the main portion, and customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information. Holstrom and Small, whether taken alone or in any reasonable combination, do not disclose or suggest the features of claim 7.

For example, Holstrom and Small do not disclose customizing at least one of the keytag portion and the main portion of each multipurpose card to include received personal information. The Examiner relies on Holstrom for allegedly disclosing "a customized card which includes personal information which reads on the 'card identifier' wherein according to Holstrom, the card can be separated into two portion to include a key tag portion through which a key chain can be inserted in (see figs.)" (final Office Action, pg. 6). Appellants submit that Holstrom does not disclose or suggest customizing the two-piece detachable card, illustrated in Figs. 1-3, with received personal information. As set forth in detail above, Holstrom does not disclose or suggest that base number 18 and tag number 20 correspond to received personal information. In fact, Holstrom does not disclose or suggest that the two-piece detachable card can be customized in any way.

The Examiner further alleges that "[t]he fact that the card is to be customized by the user or the party purchasing the card to include the 'personal information' is not directed to the claimed subject matter" (final Office Action, pg. 6, emphasis in original). Appellants' claim 7 does not recite that the customizing is performed by a user or party purchasing the card. Again,

the Examiner's allegations are directed to features not recited in Appellants' claims.

The Examiner relies on Small for allegedly disclosing "an apparatus wherein cards including prepaid telephone cards can be customized as desired by a user purchasing the card which could be a gift for a recipient" (final Office Action, pp. 6-7). While not acquiescing in the Examiner's allegation, Appellants submit that one skilled in the art would not have been motivated to incorporate Small's alleged teaching of customizing prepaid telephone cards into the Holstrom disclosure, absent impermissible hindsight.

With respect to motivation, the Examiner alleges that "it would have been obvious ... to incorporate the teaching of Small into that of Holstrom thus making it possible to customize personalized information on a card which can be used for making a call as a gift to a recipient" (final Office Action, pg. 7). Appellants disagree.

Holstrom does not disclose or suggest a desire to customize its two-piece detachable lost article tracking card. Moreover, Small does not disclose or suggest a desire to customize a card that is used for tracking lost articles. Appellants submit that the Examiner's motivation was impermissibly gleaned from Appellants' own disclosure. Without proper motivation to combine Holstrom and Small, the rejection of claim 7 is improper.

Further with respect to motivation, the Examiner alleges that "Small teaches being able to customize cards including calling cards for gift purposes with any desired information" (final Office Action, pg. 12; Advisory Action, pg. 5). As set forth in detail above, Holstrom does not disclose or suggest a calling card. Instead, Holstrom discloses a lost article tracking card. Small does not disclose or suggest a desire to customize a lost article tracking card. Therefore, one

skilled in the art would not have been motivated to combine Holstrom and Small in the manner suggested by the Examiner, absent impermissible hindsight.

For at least the foregoing reasons, Appellants submit that the rejection of claim 7 under 35 U.S.C. § 103(a) based on Holstrom in view of Small is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 12 recites that the customizing includes adding one or more of a company logo, personal expression, and a photograph. Claim 12 depends from claim 7. Therefore, claim 12 is patentable over Holstrom and Small, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 7. Moreover, claim 12 is patentable over Holstrom and Small for reasons of its own.

With respect to claim 12, the Examiner refers to the explanation regarding claim 7. Claim 7, however, does not recite adding one or more of a company logo, personal expression, and a photograph. The Examiner fails to address the specific feature of claim 12. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 12.

Moreover, even assuming, for the sake of argument, that Small discloses adding one or more of a company logo, personal expression, and a photograph to a card, Appellants submit that one skilled in the art would not have been motivated to incorporate this teaching of Small into the Holstrom system absent impermissible hindsight.

As set forth above, Holstrom does not disclose or suggest customizing its lost article tracking card. Moreover, Small does not disclose or suggest a desire to customize a lost article

tracking card. Therefore, one skilled in the art would not have been motivated to combine Holstrom and Small in the manner suggested by the Examiner, absent impermissible hindsight.

For at least the foregoing reasons, Appellants submit that the rejection of claim 12 under 35 U.S.C. § 103(a) based on Holstrom in view of Small is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 20 recites that the processor is configured to add at least one of a company logo, personal expression, and a photograph to the main portion and the keytag portion of the multipurpose card. Claim 20 depends from claim 16. Therefore, claim 20 is patentable over Holstrom and Small, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 16. Moreover, claim 20 is patentable over Holstrom and Small for reasons of its own.

With respect to claim 20, the Examiner alleges "[t]he combination teaches being able to customize a card to include information which could include personal expression" (final Office Action, pg. 8). As set forth above, Holstrom does not disclose or suggest customizing a card. Therefore, Holstrom cannot disclose or suggest customizing the main portion and the keytag portion of a multipurpose card to include at least one of a company logo, personal expression, and a photograph, as required by claim 20. Moreover, since Small does not disclose or suggest a card that includes a main portion and a keytag portion, Small cannot disclose customizing the main portion and the keytag portion of a multipurpose card to include at least one of a company logo, personal expression, and a photograph.

The Examiner further alleges that "it would have been obvious ... that desired

information can be placed anywhere on the card as desired by a user or purchaser wherein the personal expressions could including messages or greetings such as taught by Small" (final Office Action, pg. 12). Appellants disagree.

The Examiner's allegations are merely conclusory and insufficient for establishing a *prima facie* basis for denying patentability. As set forth above, neither Holstrom nor Small discloses or suggests customizing the main portion and the keytag portion of a multipurpose card to include at least one of a company logo, personal expression, and a photograph. The Examiner's conclusory allegation that desired information can be placed anywhere on the card is unsupported by the Holstrom and Small disclosures.

For at least the foregoing reasons, Appellants submit that the rejection of claim 20 under 35 U.S.C. § 103(a) based on Holstrom in view of Small is improper. Accordingly, Appellants request that the rejection be reversed.

Claim 27 recites that the receiving includes receiving a request for one or more multipurpose calling cards, gift cards, and credit cards. Claim 27 depends from claim 25. Therefore, claim 27 is patentable over Holstrom and Small, whether taken alone or in any reasonable combination, for at least the reasons given above with respect to claim 25. Moreover, claim 27 recites an additional feature not disclosed or suggested by Holstrom and Small.

With respect to claim 27, the Examiner alleges "[t]he combination including Holstrom teaches the claimed subject matter" (final Office Action, pg. 8). The Examiner fails, however, to specifically address the feature recited in Appellants' claim 27. Accordingly, a *prima facie* case of obviousness has not been established with respect to claim 27. Appellants submit that

Holstrom and Small, whether taken alone or in any reasonable combination, do not disclose or suggest receiving a request for one or more multipurpose calling cards, gift cards, and credit cards.

For at least the foregoing reasons, Appellants submit that the rejection of claim 27 under 35 U.S.C. § 103(a) based on Holstrom in view of Small is improper. Accordingly, Appellants request that the rejection be reversed.

D. The rejection of claim 30 under 35 U.S.C. § 103(a) as unpatentable over Holstrom (U.S. Patent No. 5,570,081) in view of Taskett (U.S. Patent No. 5,684,291), and further in view of MacWilliams et al. (U.S. Patent No. 6,385,860) should be REVERSED.

Claim 30 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Holstrom in view of Taskett, and further in view of MacWilliams et al.

MacWilliams et al. is directed to a method for consistently applying and aligning labels (Abstract).

Claim 30 depends from claim 28. Appellants submit that the disclosure of MacWilliams et al. does not remedy the deficiencies in the disclosures of Holstrom and Taskett set forth above with respect to claim 28. Moreover, claim 30 recites an additional feature not disclosed or suggested by the combination of Holstrom, Taskett, and MacWilliams et al.

Claim 30 recites placing a label on the perforation that is used to create a first calling card portion and a second portion in the calling card. The Examiner admits that Holstrom and Taskett do not disclose this feature and relies on Figs. 1 and 5 of MacWilliams et al. for allegedly

disclosing "a label ... placed on a perforation to protect the perforated means" (final Office Action, pg. 9). Appellants submit that these sections of MacWilliams et al. do not disclose or suggest the feature of claim 30.

Figs. 1 and 5 of MacWilliams et al. discloses a label form 100/500 that includes a label member 101/501 that is formed on a backing member that includes perforations 111/511. The perforations allow for the backing member to be bent, thereby facilitating the removal of label member 101/501 (col. 3, lines 32-35 and 47-51; col. 5, lines 25-27). Contrary to the Examiner's allegation, MacWilliams et al. does not disclose or suggest placing a label on a perforation. Moreover, MacWilliams et al. in no way discloses or suggests that the label is placed on the perforation to protect the perforation means, as alleged by the Examiner.

Even assuming, for the sake of argument, that MacWilliams et al. disclosing placing a label on a perforation, as alleged by the Examiner, Appellants submit that one skilled in the art would not have been motivated to incorporate the teachings of MacWilliams et al. into the Holstrom system, absent impermissible hindsight.

With respect to motivation, the Examiner alleges "it would have been obvious ... to incorporate this teaching into that of the primary references as means of providing a label covering the two-piece perforated piece for protection purposes" (final Office Action, pg. 9). Appellants disagree.

Holstrom does not disclose or suggest a desire to place a label on a perforation for protection purposes. In fact, Holstrom does not disclose or suggest a perforation. Moreover, MacWilliams et al. does not disclose or suggest placing a label on a perforation for protection

purposes. Instead, MacWilliams et al. discloses, as described above, a label member 101/501 that is formed on a backing member that includes perforations 111/511. Further, even assuming that MacWilliams et al. discloses placing a label on a perforation, it is unclear as to what form of protection the Examiner alleges the label would provide. Appellants submit that the Examiner's motivation to combine the teachings of MacWilliams et al. with Holstrom's lost article tracking card has been impermissibly gleaned from Appellants' own disclosure.

For at least the foregoing reasons, Appellants submit that the rejection of claim 30 under 35 U.S.C. § 103(a) based on Holstrom in view of Taskett, and further in view of MacWilliams et al. is improper. Accordingly, Appellants request that the rejection be reversed.

IX. CONCLUSION

In view of the foregoing arguments, Appellants respectfully solicit the Honorable Board to reverse the outstanding rejections of claims 1-4 and 6-30.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 13-2491 and please credit any excess fees to such deposit account.

Respectfully submitted,

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APPENDIX

1. A multipurpose calling card comprising:
a calling card portion; and
a key ring portion, the key ring portion being separable from the calling card portion,
wherein a size of the multipurpose calling card is approximately a size of a conventional calling card.
2. The multipurpose calling card of claim 1 wherein the key ring portion includes:
one or more of promotional information, personal expressions, and photographs.
3. The multipurpose calling card of claim 1 wherein the key ring portion includes:
a hole that allows the key ring portion to be attached to a key ring.
4. The multipurpose calling card of claim 1 further comprising:
a perforation located between the calling card portion and the key ring portion, the perforation facilitates the separation of the calling card portion and the key ring portion.
6. The multipurpose calling card of claim 1 wherein the calling card portion and the key ring portion include an identification number for placing a telephone call.

7. A method for manufacturing customized cards, comprising:
receiving personal information;
generating one or more multipurpose cards, each multipurpose card including a main portion and a keytag portion, the keytag portion being separable from the main portion; and
customizing at least one of the keytag portion and the main portion of each multipurpose card to include the personal information.

8. The method of claim 7 wherein the generating includes:
generating one or more multipurpose calling cards.

9. The method of claim 8 wherein the generating includes:
generating one or more multipurpose prepaid telephone cards.

10. The method of claim 7 wherein the generating includes:
generating one or more multipurpose gift cards.

11. The method of claim 7 wherein the generating includes:
generating one or more multipurpose credit cards.

12. The method of claim 7 wherein the customizing includes:
adding one or more of a company logo, personal expression, and a photograph.

13. The method of claim 7 wherein the customizing includes:
adding the personal information to both the main portion and the keytag portion of each multipurpose card.
14. The method of claim 7 wherein the generating includes:
adding an identification number to both the main portion and the keytag portion of each multipurpose card.
15. A system for manufacturing customized multipurpose cards, comprising:
means for creating at least one multipurpose card, the at least one multipurpose card including a main portion and a keytag portion, the keytag portion being separable from the main portion; and
means for adding, to at least one of the keytag portion and the main portion of the at least one multipurpose card, information specified by a user.
16. A system for providing a customized multipurpose card, comprising:
a memory configured to store instructions; and
a processor configured to execute the instructions to obtain a blank multipurpose card, the multipurpose card having a main portion and a keytag portion, customize the main portion and the keytag portion, and issue the customized multipurpose card.

17. The system of claim 16 wherein the main portion and the keytag portion are separable.

18. The system of claim 17 wherein the keytag portion includes a hole that allows the keytag portion to be attached to a key ring.

19. The system of claim 16 wherein the multipurpose card is one of a calling card, a gift card, and a credit card.

20. The system of claim 16 wherein, when customizing, the processor is further configured to:

add at least one of a company logo, personal expression, and a photograph to the main portion and keytag portion of the multipurpose card.

21. The system of claim 16 wherein the processor is further configured to:
add an identification number to the main portion and keytag portion of the multipurpose card.

22. A computer-readable medium containing instructions for causing at least one processor to perform a method comprising:

causing at least one multipurpose card to be generated, the at least one
multipurpose card having a main portion and a keytag portion;
customizing the main portion and the keytag portion; and
providing the at least one customized multipurpose card.

23. The computer-readable medium of claim 22 wherein the customizing includes:
adding one or more of a company logo, personal expression, and a photograph to
the main portion and the keytag portion of each of the at least one multipurpose card.

24. The computer-readable medium of claim 22 wherein the method further includes:
adding an identification number to the main portion and the keytag portion of each
of the at least one multipurpose card.

25. A method for providing customized cards, comprising:
receiving a request for one or more multipurpose cards having a main portion and
a keytag portion, the request including personalized information to be added to the multipurpose
cards;
modifying the main portion and keytag portion of each multipurpose card to
include the personalized information; and
providing the modified cards.

26. The method of claim 25 wherein the main portion and keytag portion of each multipurpose card are separable.

27. The method of claim 25 wherein the receiving includes:
receiving a request for one or more multipurpose calling cards, gift cards, and credit cards.

28. A method for manufacturing a calling card, comprising:
generating a card, the card being substantially a size of a conventional calling card;
creating a perforation to create a first calling card portion and a second portion;
and
forming a hole in the second portion.

29. The method of claim 28 wherein the creating includes:
creating 5 or 6 perforations between the first calling card portion and the second portion.

30. The method of claim 28 further comprising:
placing a label on the perforation.